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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,565	08/06/2001	Atsushi Fukumoto	50099-172	7049

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MCDERMOTT, WILL & EMERY  
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WASHINGTON, DC 20005-3096

EXAMINER

LAstra, DANIEL

ART UNIT PAPER NUMBER

3622

DATE MAILED: 06/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/921,565

Applicant(s)

FUKUMOTO, ATSUSHI

Examiner

DANIEL LASTRA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 16 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>08/06/01</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-10 have been examined. Application 09/921,565 (Personal information application system) has a filing date 08/06/2001 and foreign date 02/06/2001.

#### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 2, 4, 5 and 7-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The basis of this rejection is set forth in whether the invention produces a useful, concrete, and tangible result. In the present application, said claims 1-15 do not recite a "useful, concrete and tangible result". The claims are storing data in a storing processors without any practical application to said data.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 4 and 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites "said personal information terminal thereto without a network". Said limitation is indefinite because it does not clearly teaches if said personal information is connected through a network or not. Claims 4

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and 7 recite "an electronic settlement function". Said claims are indefinite because they don't explain the meaning of said electronic settlement function. For purpose of art rejection, said claims would be interpreted as a personal computer performing a purchase transaction.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Herz (US 6,571,279).

As per claim 1, Herz teaches:

A personal information application system comprising:

a personal information terminal recording personal information related to a consumer being its owner as electronic data (see col 20, lines 48-60; col 6, lines 17-22);  
and

an information processing part, having a connection interface capable of connecting said personal information terminal thereto without through a network, recording advertisement information related to merchandise and/or service as electronic data (see col 15, lines 55-67), wherein said information processing part reads said

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personal information and said personal information terminal reads said advertisement information when said personal information terminal is connected to said information processing part through said connection interface (see col 16, lines 13-22).

As per claim 2, Herz teaches:

The personal information application system according to claim 1, wherein said personal information includes information related to merchandise and/or service desired by said consumer (see col 6, lines 16-33), and

said advertisement information includes advertisement information related to merchandise and/or service desired by said consumer selected on the basis of previously read said personal information (see col 6, lines 16-34; col 22, lines 65-67).

As per claim 3, Herz teaches:

The personal information application system according to claim 2, wherein said information processing part further has a display part for displaying advertisement information related to said merchandise and/or service desired by said consumer when said personal information terminal is electrically connected to said information processing part through said connection interface (see col 26, lines 49-60).

As per claim 4, Herz teaches:

The personal information application system according to claim 1, wherein said personal information terminal and said information processing part have an electronic settlement function (see col 26, lines 50-57; col 27, lines 1-15), and

said electronic settlement function is executable when said personal information terminal is connected to said information processing part through said connection interface (see col 26, lines 50-57; col 27, lines 1-15).

As per claim 5, Herz teaches:

A personal information application system comprising:

a personal information terminal recording personal information related to a consumer being its owner as electronic data (see col 20, lines 48-60; col 6, lines 17-22);  
and

a plurality of information processing parts, connectable with said personal information terminal through or without through a network, recording advertisement information related to merchandise and/or service as electronic data (see col 15, lines 55-67), wherein one of said information processing parts reads said personal information and said personal information terminal reads said advertisement information when said personal information terminal is connected to said one of said information processing parts (see col 16, lines 13-22), and

said personal information is electronic data recorded in a common format readable by all said plurality of information processing parts (see col 6, lines 17-33).

As per claim 6, Herz teaches:

The personal information application system according to claim 5, wherein every said advertisement information from said plurality of information processing parts is displayed in a common display form in said personal information terminal (see col 26, lines 49-55).

As per claim 7, Herz teaches:

The personal information application system according to claim 5, wherein said personal information terminal and said plurality of information processing parts have an electronic settlement function (see col 26, lines 49-55), and

said electronic settlement function is executable when said personal information terminal is connected to said information processing part (see col 26, lines 49-55).

As per claim 8, Herz teaches:

A personal information application system comprising:

a plurality of personal information terminals recording personal information related to consumers being owners thereof as electronic data (see col 20, lines 48-60; col 6, lines 17-22);

a plurality of first information processing parts recording advertisement information related to merchandise and/or service as electronic data (see col 15, lines 55-67); and

a second information processing part connectable with said personal information terminals and said first information processing parts through or without through a network for reading said personal information and said advertisement information from said personal information terminals and said first information processing parts and recording the same, wherein said personal information includes information related to merchandise and/or service desired by said consumers (see col 15, lines 55-67),, and

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said second information processing part transmits consumer information related to general trends of consumers created on the basis of said personal information to said first information processing parts (see col 16, lines 7-22),

while transmitting advertisement information related to said merchandise and/or service desired by said consumers selected from said advertisement information on the basis of previously read said personal information to said personal information terminals (see col 16, lines 7-22).

As per claim 9, Herz teaches:

The personal information application system according to claim 8, wherein said first information processing parts are capable of reading said personal information recorded in said second information processing part (see col 20, lines 47-60).

As per claim 10, Herz teaches:

The personal information application system according to claim 8, wherein said personal information terminals and said first information processing parts are connectable with each other through or without through a network (see col 20, lines 48-60; col 6, lines 17-22);

said personal information terminals and said first information processing parts have an electronic settlement function and said electronic settlement function is executable when said personal information terminals are connected to said fast information processing parts (see col 26, lines 49-60).



***Conclusion***

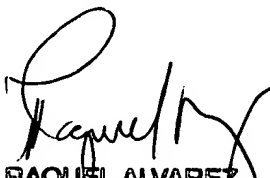
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL

Daniel Lastra  
June 12, 2006

  
RAQUEL ALVAREZ  
PRIMARY EXAMINER